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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/646,478	03/04/2002	Jin Jen	126881201800	1461

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EXAMINER	
RAWLINGS, STEPHEN L	
ART UNIT	**PAPER NUMBER**
1642	

DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/646,478	JEN ET AL.	
	Examiner	Art Unit	
	Stephen L. Rawlings, Ph.D.	1642	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-30 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) 1-30 are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-30 are pending in the application and are currently subject to restriction.

Election/Restrictions

2. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1, 2, 6, 7, 11, and 30, drawn to a method for aiding in the diagnosis of a neoplastic condition of the lung comprising detecting the presence of overexpressed b-myb in a lung cell sample, wherein the presence of an overexpressed proto-oncogene is determined by detecting the quantity of mRNA transcribed from the proto-oncogene, and a kit for practicing said method.

Group II, claim(s) 1, 3, 6, 8, 11, and 30, drawn to a method for aiding in the diagnosis of a neoplastic condition of the lung comprising detecting the presence of overexpressed PGP9.5 in a lung cell sample, wherein the presence of an overexpressed proto-oncogene is determined by detecting the quantity of mRNA transcribed from the proto-oncogene, and a kit for practicing said method.

Group III, claim(s) 1, 4, 6, 9, 11, and 30, drawn to a method for aiding in the diagnosis of a neoplastic condition of the lung comprising detecting the presence of overexpressed 8-oxo-dGTPase in a lung cell sample, wherein the presence of an overexpressed proto-oncogene is determined by detecting the quantity of mRNA transcribed from the proto-oncogene, and a kit for practicing said method.

Group IV, claim(s) 1, 5, 6, 10, 11, and 30, drawn to a method for aiding in the diagnosis of a neoplastic condition of the lung comprising detecting the presence of overexpressed p67 in a lung cell sample, wherein the presence of an overexpressed proto-oncogene is determined by detecting the quantity of mRNA transcribed from the proto-oncogene, and a kit for practicing said method.

Group V, claim(s) 1, 2, 12, and 13, drawn to a method for aiding in the diagnosis of a neoplastic condition of the lung comprising detecting the presence of overexpressed b-myb in a lung cell sample, wherein the presence of an overexpressed proto-oncogene is determined by detecting the quantity of the polypeptide or protein encoded by the proto-oncogene.

Group VI, claim(s) 1, 3, 12, and 13, drawn to a method for aiding in the diagnosis of a neoplastic condition of the lung comprising detecting the presence of overexpressed PGP9.5 in a lung cell sample, wherein the presence of an overexpressed proto-oncogene is determined by detecting the quantity of the polypeptide or protein encoded by the proto-oncogene.

Group VII, claim(s) 1, 4, 12, and 13, drawn to a method for aiding in the diagnosis of a neoplastic condition of the lung comprising detecting the presence of overexpressed 8-oxo-dGTPase in a lung cell sample, wherein the presence of an overexpressed proto-oncogene is determined by detecting the quantity of the polypeptide or protein encoded by the proto-oncogene.

Group VIII, claim(s) 1, 5, 12, and 13, drawn to a method for aiding in the diagnosis of a neoplastic condition of the lung comprising detecting the presence of overexpressed p67 in a lung cell sample, wherein the presence of an overexpressed proto-oncogene is determined by detecting the quantity of the polypeptide or protein encoded by the proto-oncogene.

Group IX, claim(s) 14 and 15, drawn to a screen for a potential therapeutic agent for the reversal of a neoplastic condition of the lung characterized by the overexpression of b-myb.

Group X, claim(s) 14 and 16, drawn to a screen for a potential therapeutic agent for the reversal of a neoplastic condition of the lung characterized by the overexpression of PGP9.5.

Group XI, claim(s) 14 and 17, drawn to a screen for a potential therapeutic agent for the reversal of a neoplastic condition of the lung characterized by the overexpression of 8-oxo-dGTPase.

Group XII, claim(s) 14 and 18, drawn to a screen for a potential therapeutic agent for the reversal of a neoplastic condition of the lung characterized by the overexpression of p67.

Group XIII, claim(s) 19, 20, and 24, drawn to a method for reversing a neoplastic condition of the lung characterized by the overexpression of b-myb.

Group XIV, claim(s) 19, 21, and 24, drawn to a method for reversing a neoplastic condition of the lung characterized by the overexpression of PGP9.5.

Group XV, claim(s) 19, 22, and 24, drawn to a method for reversing a neoplastic condition of the lung characterized by the overexpression of 8-oxo-dGTPase.

Group XVI, claim(s) 19, 23, and 24, drawn to a method for reversing a neoplastic condition of the lung characterized by the overexpression of p67.

Group XVII, claim(s) 25 and 29, drawn to a probe or a primer, or a solid support comprising said probe or primer, wherein said probe or primer comprises SEQ ID NO: 1 or its complement.

Group XVIII, claim(s) 26 and 29, drawn to a probe or a primer, or a solid support comprising said probe or primer, wherein said probe or primer comprises SEQ ID NO: 2 or its complement.

Group XIX, claim(s) 27 and 29, drawn to a probe or a primer, or a solid support comprising said probe or primer, wherein said probe or primer comprises SEQ ID NO: 3 or its complement.

Group XX, claim(s) 28 and 29, drawn to a probe or a primer, or a solid support comprising said probe or primer, wherein said probe or primer comprises SEQ ID NO: 4 or its complement.

3. The inventions listed as Groups I-XX do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The special technical feature of group I is detecting the presence of overexpressed b-myb in a lung cell sample by detecting the quantity of mRNA transcribed from the proto-oncogene.

The special technical feature of group II is detecting the presence of overexpressed PGP9.5 in a lung cell sample by detecting the quantity of mRNA transcribed from the proto-oncogene.

The special technical feature of group III is detecting the presence of overexpressed 8-oxo-dGTPase in a lung cell sample by detecting the quantity of mRNA transcribed from the proto-oncogene.

The special technical feature of group IV is detecting the presence of overexpressed p67 in a lung cell sample by detecting the quantity of mRNA transcribed from the proto-oncogene.

The special technical feature of group V is detecting the presence of overexpressed b-myb in a lung cell sample by detecting the quantity of the polypeptide or protein encoded by the proto-oncogene.

The special technical feature of group VI is detecting the presence of overexpressed PGP9.5 in a lung cell sample by detecting the quantity of the polypeptide or protein encoded by the proto-oncogene.

The special technical feature of group VII is detecting the presence of overexpressed 8-oxo-dGTPase in a lung cell sample by detecting the quantity of the polypeptide or protein encoded by the proto-oncogene.

The special technical feature of group VIII is detecting the presence of overexpressed p67 in a lung cell sample by detecting the quantity of the polypeptide or protein encoded by the proto-oncogene.

The special technical feature of group IX is screening for a potential therapeutic agent for the reversal of a neoplastic condition of the lung characterized by the overexpression of b-myb.

The special technical feature of group X is screening for a potential therapeutic agent for the reversal of a neoplastic condition of the lung characterized by the overexpression of PGP9.5.

The special technical feature of group XI is screening for a potential therapeutic agent for the reversal of a neoplastic condition of the lung characterized by the overexpression of 8-oxo-dGTPase.

The special technical feature of group XII is screening for a potential therapeutic agent for the reversal of a neoplastic condition of the lung characterized by the overexpression of p67.

The special technical feature of group XIII is reversing a neoplastic condition of the lung characterized by the overexpression of b-myb.

The special technical feature of group XIV is reversing a neoplastic condition of the lung characterized by the overexpression of PGP9.5.

The special technical feature of group XV is reversing a neoplastic condition of the lung characterized by the overexpression of 8-oxo-dGTPase.

The special technical feature of group XVI is reversing a neoplastic condition of the lung characterized by the overexpression of p67.

The special technical feature of group XVII is making and using a probe or a primer, or a solid support comprising said probe or primer, wherein said probe or primer comprises SEQ ID NO: 1 or its complement.

The special technical feature of group XVIII is making and using a probe or a primer, or a solid support comprising said probe or primer, wherein said probe or primer comprises SEQ ID NO: 2 or its complement.

The special technical feature of group XIX is making and using a probe or a primer, or a solid support comprising said probe or primer, wherein said probe or primer comprises SEQ ID NO: 3 or its complement.

The special technical feature of group XX is making and using a probe or a primer, or a solid support comprising said probe or primer, wherein said probe or primer comprises SEQ ID NO: 4 or its complement.

Accordingly, groups I-XX do not share the same or corresponding special technical feature so as to form a single general inventive concept under PCT Rules 13.1 and 13.2. In addition, PCT Rules 13.1 and 13.2 do not provide for a single general inventive concept comprising more than the first mentioned produce, the mentioned method for using said product, and the first mentioned method for making said product.

4. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen L. Rawlings, Ph.D. whose telephone number is (571) 272-0836. The examiner can normally be reached on Monday-Friday, 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne (Bonnie) Eyler, Ph.D. can be reached on (571) 272-0871. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Stephen L. Rawlings, Ph.D.
Examiner
Art Unit 1642

slr
March 23, 2004

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